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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/350,197	07/08/1999	DAVID A. MONROE	58959.10.23	7703

7590

04/03/2003

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EXAMINER

CUMMING, WILLIAM D

ART UNIT

PAPER NUMBER

2684

DATE MAILED: 04/03/2003

20

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/350,197

Applicant(s)

MONROE, DAVID A.

Examiner

WILLIAM D. CUMMING

Art Unit

2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 45-64 is/are pending in the application.
- 4a) Of the above claim(s) 50-55, 57, 59, 60, 62 and 63 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 45-49, 56, 58, 61 and 64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 19 February 2003 is: a) ☐ approved b) ☒ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Drawings

1. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on February 19, 2003 have been disapproved because they introduce new matter into the drawings. 37 CFR 1.121(f) states that no amendment may introduce new matter into the disclosure of an application. The original disclosure does not support the showing of the method shown in figure 2E.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 45-49, 56, 58, 61 and 64 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

The specification fails to originally support and inadequately describe the now claimed priority data comprising programmed security characteristics relating to each of the plurality of transmission systems as stated by claims 45 and 58.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 45-49, 56, 58, 61 and 64 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 45 and 58, the term "*security characteristics*" is indefinite since it is not defined in the specification and it is unclear what are "*security characteristics*." For examination purpose only, the examiner shall take "*security characteristics*" to mean anything which can or may be use for security including security control or identifying codes, etc. The terms "*said incoming signals*" lacks antecedent basis.

Claim Rejections - 35 USC § 102

6. **Recent Statutory Changes to 35 U.S.C. § 102(e)**

On November 2, 2002, President Bush signed the 21st Century Department of Justice Appropriations Authorization Act (H.R. 2215) (Pub. L. 107-273, 116 Stat. 1758 (2002)), which further amended 35 U.S.C. § 102(e), as revised by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)). The revised provisions in 35 U.S.C. § 102(e) are completely retroactive and effective immediately for all applications being examined or patents being reexamined. Until all of the Office's automated systems are updated to reflect the revised statute, citation to the revised statute in Office actions is provided. This also substitutes for any citation of the text of 35 U.S.C. § 102(e), if made, in the Office action.

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 in view of the AIPA and H.R. 2215 that forms the basis for the rejections under this section made in the attached Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 prior to the amendment by the AIPA that forms the basis for the rejections under this section made in the attached Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

For more information on revised 35 U.S.C. § 102(e) visit the USPTO website at www.uspto.gov or call the Office of Patent Legal Administration at (703) 305-1622.

7. Claims 45-49, 56, 58, 61 and 64 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by **Kaku**.

Kaku discloses an apparatus (figures 1 and 3) for selecting one of a plurality of transmission systems (#N1...Ni) for transmitting an input signal captured by a remote device (#10) comprising a detector (#2) for detecting one or more available transmission systems (#N1...Ni). A control processor (#3, 2, 11, 4, 5) for receiving and storing priority data (*"The user may also preset priority of each of the radio telephone networks N1 to Ni in the network selector 11 by way of the keyboard according to his convenience, such as according to service charge of each of the radio telephone networks N1 to Ni, width of its service area, or robustness against movement of its mobile terminals, for instance.*

"Furthermore, there may be preset also a plurality of priority sets together with their identifying codes.")

Upon receipt of an incoming signal, the control processor extracts stored priority data (*"Now, operation of the multi-modal handy phone 10 of the embodiment is described in connection with a case where are preset a first priority set according to service charges with a first priority code `#1`, a second priority set according to widths of service areas with a second priority code `#2` and a third priority set according to robustness against movement of mobile terminals with a third priority code `#3`, by way of example.*

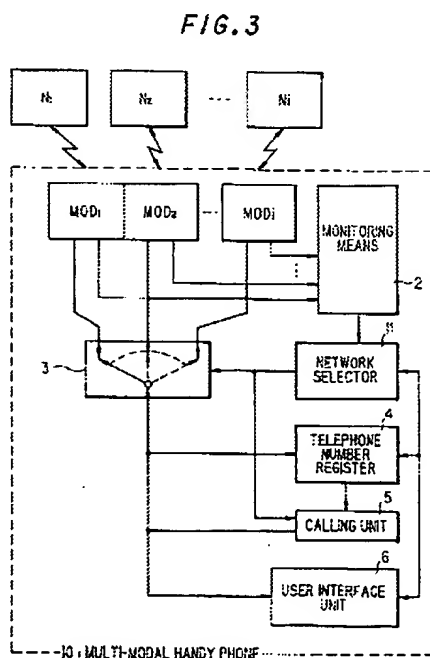
"When calling a telephone number, user of the multi-modal handy phone 10 first enters the second priority code '#2', for example, followed by the telephone number. Then, the network selector 11 of the multi-mode handy phone 10 indicates the changeover unit 3 to select all of the radio modules MOD1 to MODi sequentially for obtaining available networks {Nk} (k being a certain integer not more than i) checked by the monitoring means 2, among which the network selector 11 selects a network Nd, the PDC system for example, having a highest priority in the second priority set, and so the calling unit 5 calls the telephone number through the corresponding radio module MODd selected by the network selector 11, the telephone number information being registered in the telephone number register 4.

"When the monitoring means 2 detects degradation of the communication quality through the network Nd because of the multi-modal handy phone 10 entering into a sub-mall out of its service area, for example, the monitoring means 2 informs the network selector 11 to select another network. Then, the network selector 11 selects a network Ne among available networks {Ni} (i being a certain integer not more than i) newly checked, the PHS for example, having a highest priority in the priority set indicated by the user, '#2' in the example, in the same way as above described, and the calling unit 5 calls the telephone number registered in the telephone number register 4 by way of the corresponding radio module MODe.

"Thus, the interrupted communication can be reopened through the network N_e according to user's convenience, in the embodiment.

"When degradation of communication quality is detected during a communication through a network N_f called from the other party in case the first priority set '#1' is pre-set by the user, the network selector 11 selects a network N_g , the PHS for example, having a highest priority representing a cheapest service charge among available networks $\{N_m\}$ in the same way, through which the calling unit 5 calls the telephone number transmitted through the network N_f and registered in the telephone number register 4 for reopening the communication through the network N_g .

"Thus, also the communication called by the other party can be reopened through the network N_g according to user's convenience of the multi-modal handy phone 10, in the embodiment.



"Heretofore, the invention is described in connection with some embodiments, however other various applications of the present invention can be considered in the scope of the invention, by optionally combining certain of these embodiments.")

A connector (#3) for connecting a portable handset transceiver (#MOD1...#MODi) of the apparatus.

Regarding claims like claims 46, 64, etc., note *"When the monitoring means 2 detects degradation of the communication quality through the network Nd because of the multi-modal handy phone 10 entering into a sub-mall out of its service area, for example, the monitoring means 2 informs the network selector 11 to select another network. Then, the network selector 11 selects a network Ne among available networks {Ni} (i being a certain integer not more than i) newly checked, the PHS for example, having a highest priority in the priority set indicated by the user, '#2' in the example, in the same way as above described, and the calling unit 5 calls the telephone number registered in the telephone number register 4 by way of the corresponding radio module MODE.*

"Thus, the interrupted communication can be reopened through the network Ne according to user's convenience, in the embodiment.

"When degradation of communication quality is detected during a communication through a network Nf called from the other party in case the first priority set '#1' is pre-set by the user, the network selector 11 selects a network Ng, the PHS for example, having a highest priority representing a cheapest service charge among available networks {Nm} in the same way, through which the calling unit 5 calls the telephone number transmitted through the network Nf and registered in the telephone number register 4 for reopening the communication through the network Ng."

Regarding claims like claims 48, note #6.

Response to Amendment

8. The amendment filed February 19, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

Page 4, after line 17.

Page 7, after line 3.

Applicant is required to cancel the new matter in the reply to this Office Action.

9. AMENDMENTS MAY NOW BE SUBMITTED IN REVISED FORMAT

The United States Patent and Trademark Office (USPTO) is permitting applicants to submit amendments in a revised format as set forth below. Further details of this practice are described in *AMENDMENTS IN A REVISED FORMAT NOW PERMITTED*, signed January 31, 2003, expected to be published in Official Gazette in February, 2003 (Notice posted on the Office's web site at

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/revamdtprac.htm>).

The revised amendment format is essentially the same as the amendment format that the Office is considering adopting via a revision to 37 CFR 1.121 (Manner of Making Amendments). The revision to 37 CFR 1.121 (if adopted) will simplify amendment submission and improve file management. The Office plans to adopt such a revision to 37 CFR 1.121 by July of 2003, at which point compliance with revised 37 CFR 1.121 will be mandatory.

Effective immediately, all applicants may submit amendments in reply to Office actions using the following format. Participants in the Office's electronic file wrapper prototype¹ receiving earlier notices of the revised practice may also employ the procedures set out below.

REVISED FORMAT OF AMENDMENTS

Begin on separate sheets:

Each section of an Amendment (e.g., Claim Amendments, Specification Amendments, Remarks) should begin on a separate sheet. *For example*, in an amendment containing a.) introductory comments, b.) amendments to the claims, c.) amendments to the specification, and d.) remarks, each of these sections should begin on a separate sheet. This will facilitate the process of separately indexing and scanning of each part of an amendment document for placement in an electronic file wrapper.

Two versions of amended part(s) no longer required:

The current requirement in 37 CFR 1.121(b) and (c) to provide two versions (a clean version and a marked up version) of each replacement paragraph, section, substitute specification or claim will be waived where an amendment is submitted in the following format:

A) Amendments to the claims:

Each amendment document that includes a change to an existing claim, or submission of a new claim, **must include a complete listing** of all claims in the application. After each claim number, the status must be indicated in a parenthetical expression, and the text of each claim under examination (with markings to show current changes) must be presented. The listing will serve to replace all prior versions of the claims in the application.

- (1) The current status of all of the claims in the application, including any previously canceled or withdrawn claims, must be given. Status is indicated in a parenthetical expression following the claim number by one of the following: (original), (currently amended), (previously amended), (canceled), (withdrawn), (new), (previously added), (reinstated – formerly claim #_), (previously reinstated), (re-presented – formerly dependent claim #_), or (previously re-presented). The text of all pending claims under examination must be submitted each time any claim is amended. Canceled and withdrawn claims should be indicated by only the claim number and status.
- (2) All claims being currently amended must be presented with markings to indicate the changes that have been made relative to the immediate prior version. The changes in any amended claim should be shown by strikethrough (for deleted matter) or underlining (for added matter). An accompanying clean version is not required and should not be presented. Only claims of the status "currently amended" will include markings.
- (3) The text of pending claims not being amended must be presented in clean version, i.e., without any markings. Any claim presented in clean version will constitute an assertion that it has not been changed relative to the immediate prior version.

¹ The Office's Electronic File Wrapper prototype program is described in *USPTO ANNOUNCES PROTOTYPE OF IMAGE PROCESSING*, 1265 Off. Gaz. Pat. Office 87 (Dec. 17, 2002) ("Prototype Announcement"), and applies only to Art Units 1634, 2827 and 2834.

- (4) A claim may be canceled by merely providing an instruction to cancel. Listing a claim as canceled will constitute an instruction to cancel. Any claims added by amendment must be indicated as (new) and shall not be underlined.
- (5) All of the claims in each amendment paper must be presented in ascending numerical order. Consecutive canceled or withdrawn claims may be aggregated into one statement (e.g. Claims 1 – 5 (canceled)).

Example of listing of claims:

Claims 1-5 (canceled)

Claim 6 (withdrawn)

Claim 7 (previously amended): A bucket with a handle.

Claim 8 (currently amended): A bucket with a ~~green~~ blue handle.

Claim 9 (withdrawn)

Claim 10 (original): The bucket of claim 8 with a wooden handle.

Claim 11 (canceled)

Claim 12 (new): A bucket with plastic sides and bottom.

Claim 13 (previously added): A bucket having a circumferential upper lip.

Claim 14 (re-presented – formerly claim 11): A black bucket with a wooden handle.

B) Amendments to the specification:

Amendments to the specification may be made by presenting a replacement paragraph, section or substitute specification marked up to show changes made relative to the immediate prior version. An accompanying clean version is not required and should not be presented.

C) Amendments to drawing figures:

Drawing changes may be made by presenting replacement figures which incorporate the proposed changes and which comply with § 1.84. An explanation of the changes made must be presented in the remarks section of the amendment. If the changes to the drawing figure(s) are not approved by the examiner, applicant will be informed in the next Office action. Any replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. The figure or figure number of the amended drawing should not be labeled as "amended."

Any questions regarding the submission of amendments pursuant to the revised practice set forth in this flyer should be directed to the following legal advisors in the Office of Patent Legal Administration (OPLA): Elizabeth Dougherty (Elizabeth.Dougherty@uspto.gov), Gena Jones (Eugenia.Jones@uspto.gov) or Joe Narcavage (Joseph.Narcavage@uspto.gov). For information on the waiver or legal aspects of the prototype, please contact Jay Lucas (Jay.Lucas@uspto.gov), Senior Legal Advisor (PCTLA) or Rob Clarke (Robert.Clarke@uspto.gov), Senior Legal Advisor (OPLA). Alternatively, further information may be obtained by calling OPLA at (703) 305-1616.

Response to Arguments

10. Applicant's arguments with respect to claims 45-49, 56, 58, 61 and 64 have been considered but are moot in view of the new grounds of rejection.

Conclusion

11. The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 2683.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Zicker discloses a method of selecting the cellular system with which a cellular mobile radio telephone communicates.

Itoh shows a portable telephone system.

Slekys, et al disclose a cellular data overlay system for storing data identifying selected data allocated channels.

Schellinger, et al show a dual system cellular cordless radio telephone with sub data channel timing monitor.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

14. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

USPTO Changes Correspondence Addresses
Under Secretary and Commissioner for Patents To Get New Addresses

15. The Department of Commerce's United States Patent and Trademark Office (USPTO) is changing some of its mailing addresses so all correspondence will be routed through a United States Postal Service facility in northern Virginia, in preparation for its move to new office space in Alexandria, VA, beginning at the end of this year.

16. Effective May 1, 2003, the general address for the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office, as well as for the Commissioner for Patents will be:

PO Box 1450
Alexandria, VA 22313-1450

17. The address for the Commissioner for Trademarks and other trademark-related correspondence will not change.

18. The USPTO has separate mailing addresses for other subject-specific correspondence. To determine the appropriate addresses for such correspondence, customers should check the USPTO Web site www.uspto.gov.

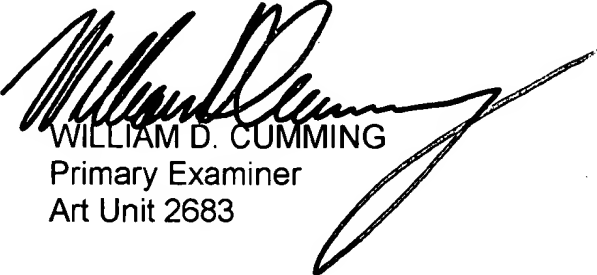
19. For additional information, refer to the Federal Register, Vol. 68, No.57
<http://www.uspto.gov/web/offices/com/sol/notices/68fr14332.pdf>

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **WILLIAM D. CUMMING** whose telephone number is **703-305-4394**. The examiner can normally be reached on Monday-10:30am to 8:00pm, Tuesday and Wednesday 11:30am to 8:30pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **WILLIAM TROST** can be reached on 703-308-5318. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-6075 for regular communications and 703-746-6075 for After Final communications.

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21. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.


WILLIAM D. CUMMING
Primary Examiner
Art Unit 2683

wdc
April 1, 2003



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